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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,232	10/03/2003	Shigeki Fujihara	FUJ13002/EM	8610

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EXAMINER
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LAVINDER, JACK W

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/677,232

Applicant(s)

FUJIHARA ET AL.

Examiner

Jack W. Lavinder

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the preamble of the claim sets forth a clip fixing structure having a clip set section that receives a rear part of a clip section of a clip. Next, the claim states "said clip set section is provided with fixing piece sections, which are bent in opposition to one another to form a width shape approximate to a shape of the clip set section". How can the clip set section be bent to form a width shape approximate to a shape of itself? It will be assumed that applicant intended to claim the following "said fixing section of the clip section is provided with fixing piece sections, which are bent in opposition to one another to form a width shape approximate to a shape of the clip set section".

In the third paragraph, it will also be assumed that applicant intended to claim the following "said fixing section of the clip section is adapted in at least a forward or rearward size and a width size of an inner space constituted by at least said fixing piece sections"? Otherwise, it is not understood from the drawings or disclosure as to how

Art Unit: 3677

the clip set section (3) can have a width size of an inner space constituted by at least said fixing piece sections.

Regarding claim 3, the same problems as indicated for claim 1 are also found in this claim.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ganz, 3920337.

Regarding claim 1, Ganz discloses a clip fixing structure having a fixing section (52, figure 3) pushed onto and fitted over a clip set section (23, figure 3) formed on a cylinder (18) to attach a clip (49) to the cylinder. The fixing section having fixing piece sections (52) with a part that functions as a fixing reference point (could be either 50, 56 or slots 54). The clip-set-section having locations (27, 28) at both sides for holding the fixing section (52) to the clip set section (figure 3).

Regarding claim 2, Ganz discloses engaging sections, which are holes (see location at 54 in figure 1) and holding sections, which are protrusions (27-29, figure 1).

Regarding claim 3, Ganz is applied as started above with regard to claim 1. Ganz further discloses tapers (29) on the upper half sections of the holding sections (27, 28).

Art Unit: 3677

Regarding claims 4 and 5, Ganz discloses the lower portion of the holding sections are formed with stoppers (27) for the fixing pieces, i.e., the sharp rise from the surface 26 of the protrusions form the stoppers, one on each side. These stoppers, i.e., the bottom portion of the protrusions, prevent the clip from disengaging from the cylinder when it is moved between its first and second positions (figures 2 and 2A).

Regarding claims 6-9, the top portion of element 24 is engaged with the upper sidewalls of the fixing section (52). This is considered to be an anti-lateral vibration means that functions to prevent lateral movement or vibration between the clip and the clip set section. Or the slot 20 engaging the sidewalls 52 could also be reasonably considered to be the anti-lateral vibration means.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganz, 3920337 in view of Saitou, 6682245.

Regarding claims 10 and 11, Ganz fails to disclose engaging sections formed as concaved outward notches and the holding sections as protrusions adapted at least to a concave inner contour shape of the engaging sections, i.e., Ganz discloses a slot for engaging the holding protrusion rather than an outwardly formed concave notch.

Art Unit: 3677

Saitou discloses that it is old and well known to use a concaved notch with a concaved protrusion (20c, 12g) to help secure the clip to the pen. The means to fasten the clip to the clip set section in Saitou is an alternative design choice to the hole and protrusion fastening system in Ganz. These are considered to be design equivalents of one another because they both perform the intended function of securely holding the clip to the clip set section, equally as well as the other. Furthermore, the specification fails to show any criticality as to the use of this specific type of protrusion and recess securing device.

It would have been obvious design alternative to a person having ordinary skill in the art to use a concave recess and protrusion-securing means, as taught by Saitou, in place of Ganz's hole and protrusion securing means for engaging the clip set section to the clip.

Regarding claim 11, Saitou was previously applied to change the hole into an outwardly shaped protrusion having a concave inner area that would engage the outwardly protruding holding means. Claim 11 now calls for the engaging section to protrude inwardly to mate with an inwardly extending recess adapted to engage the outer contour of the engaging section. The later is exactly the embodiment shown in Saitou. The above reasons for obviousness stated for claim 10 also apply here.

### ***Response to Arguments***

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

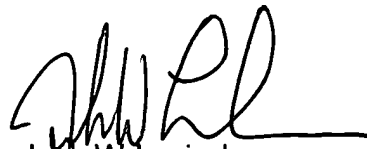
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 703-308-3421. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3677

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack W Lavinder  
Primary Examiner  
Art Unit 3677

2/14/05